



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,693	11/07/2000	Se-Jin Lee	JHU 1120-15	2065
28213	7590	12/07/2005	EXAMINER	
DLA PIPER RUDNICK GRAY CARY US, LLP 4365 EXECUTIVE DRIVE SUITE 1100 SAN DIEGO, CA 92121-2133			ALLEN, MARIANNE P	
			ART UNIT	PAPER NUMBER
			1647	
DATE MAILED: 12/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/708,693

Applicant(s)

LEE ET AL.

Examiner

Marianne P. Allen

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 9-11, 15, 19-22 and 26-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-11, 15, 19-22 and 26-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

Art Unit: 1647

### **DETAILED ACTION**

A final rejection was mailed in this application on 5/7/02. Applicant submitted an after final amendment on 9/30/02. An advisory action was mailed on 11/4/02. Applicant filed a Notice of Appeal on 11/13/02. The application was suspended by the Office on 1/13/03. Examination in this application is hereby resumed. Finality of the prior Office action mailed 5/7/02 is hereby withdrawn.

The advisory action mailed 11/4/02 is inconsistent in stating both that the after final amendment would and would not be entered. Furthermore, the advisory action does not make clear the status of all pending claims.

The examiner has entered the amendment filed 9/30/02. Claims 1-4, 9-11, 15, 19-22, 26-41 are pending. Claims 5-8, 12-14, 16-18 and 23-25 have been cancelled. The record reflects that only SEQ ID NOS: 3 and 4 for murine promyostatin were under examination due to a species election. However, as no art rejections are presently of record, the species election is withdrawn and claims 1-4, 9-11, 15, 19-22, 26, and 30-41 have been fully examined.

### ***Specification***

Applicant is requested to update the status of the co-pending applications referenced in the specification.

### ***Claim Objections***

Applicant is advised that should claim 4 be found allowable, claims 30 and 36 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing,

Art Unit: 1647

despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicant is advised that should claim 15 be found allowable, claim 31 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Double Patenting***

Claims 1-4, 9-11, 15, 19-22, and 27-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-11 of U.S. Patent No. 5,827,733. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to overlapping embodiments of murine and human GDF-8 polynucleotides, vectors, and host cells.

While the after final amendment submitted 9/30/02 refers to a terminal disclaimer, no terminal disclaimer appears to have been submitted.

Claims 19-22, 27-29, and 32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,500,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to overlapping embodiments of murine and human GDF-8 polynucleotides, vectors, and host cells.

Art Unit: 1647

Claims 1-3, 9-11, 19-21, 26, 32-35, and 38-41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,465,239. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to overlapping embodiments of piscine GDF-8 polynucleotides, vectors, and host cells.

The provisional double patenting rejection over claims 21-23 of 09/628,112 set forth in the final rejection is withdrawn due to cancellation of these claims.

#### ***Claim Rejections - 35 USC § 112***

Claims 1-3, 9-11, 19-21, 27-29, 32-35, and 38-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection is maintained for reasons of record as applied to claims 1-4, 9-22, and 27-29 in the final rejection and advisory action and applied to new claims 32-35 and 38-40 for the same reasons. In the absence of a particular sequence to reference, amino acid position ranges have no meaning.

Art Unit: 1647

Claims 1-3, 9-11, 19-21, 27-29, 32-35, and 38-40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the particular sequences disclosed, does not reasonably provide enablement for all sequences embraced by the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

This rejection is maintained for reasons of record as applied to claims 1-4, 9-22, and 27-29 in the final rejection and advisory action and applied to new claims 32-35 and 38-40 for the same reasons.

Claim 11, 32, and 40 are directed to cells. As written, the claims embrace transgenic animals and plants that have not been enabled. Note that claims 32 and 40 do not indicate that the cell is isolated.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1647

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Marianne P. Allen  
Primary Examiner  
Art Unit 1647

mpa